

Remarks

Status of the Claims

By this amendment, claims 1-18 are cancelled, and new claims 19-36 are added. Each new claim finds support in the original claims and throughout the specification. No new matter has been added. Upon entry of this Amendment, claims 19-36 will be pending.

Objections to the Drawings

The drawings were objected to under Rule 83(a) and Rule 84(p)(5). Office action ¶ 4-5. The present version of the drawings avoid each issue.

The objection under Rule 83(a) required that the drawings show “[t]he Discharge Triggering means or that the feature be removed from the claims.” *Id.* ¶4. This feature is not recited in the claims. Thus, this objection should be withdrawn.

The objection under Rule 84(p)(5) stated that the drawings “do not include the following reference sign(s) mentioned in the description: (132).” *Id.* ¶5. It is believed that (132) is mentioned at page 8, line 21; page 17, line 16; page 18, line 11; and page 19, line 38. Each occurrence of (132) is preceded by the term “sample plate.” The “sample plate” finds its antecedent basis at page 7, line 25 of the present specification, where the term “a removable sample plate 130” appears. Thus, it is submitted that references to 132 should have been to 130, a solution to an obvious error that would have been recognizable to one of ordinary skill in the art.

The present amendment replaces “132” with --130-- where indicated. Thus, this objection should be withdrawn.

In accordance with 37 C.F.R. § 1.83(a), the drawings must show every feature of the invention specified. Accordingly, Figure 1 includes a claimed stepper or DC motor (195), and Figure 2 includes a refrigeration tray (131c). The specification has been amended accordingly.

Objections to the Specification

The Abstract has been objected to. Id. ¶6-7. The present Abstract avoids these issues. Thus, the objection should be withdrawn.

The Disclosure is objected to for containing “informalities.” Id. ¶8. Not all of those “informalities” are, however, requirements. The present amendment adds section headings “Brief Description of the Drawings” and “What Is Claimed Is.” The other informalities are not required by the rules and should not be a basis for a sound objection. Nevertheless, the amendment also adds the section heading, “Embodiments of the Invention.” Thus, this objection should be withdrawn.

The Title has been objected to for using the term “WITH A VIEW TO IMPLEMENTING.” Id. ¶ 10. The present Title avoids this issue, and, thus, the objection should be withdrawn.

Claim Objections

Claims 2-4 have been objected to as dependent claims that fail to further limit the base independent claim. Id. ¶ 11. These claims have been cancelled. The present version of the claims avoids this issue. Thus, the objection should be withdrawn.

Claims 5-18 have been objected to for improper multiple dependencies. These claims have been cancelled. Id. ¶ 12. The present version of the claims avoids this issue. Thus, the objection should be withdrawn.

Rejections- 35 U.S.C. § 112, second paragraph

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. These claims are cancelled. Moreover, the present version of the claims avoids each issue as explained below. As there are numerous indefiniteness rejections, each is addressed and enumerated as in the Office action, ¶¶ 14-33.

15. Claims 1-4 have been rejected for reciting "characterized in that." Office action, ¶ 15. The present version of the claims avoids this issue. Thus, the rejection should be withdrawn.

16. Claim 1 has been rejected because the preamble recites "redundant" terms, namely, both "producing a plurality of reaction samples" and "implementing chemical or biological reactions." Office action, ¶ 16. The first term is in claim 19, but the second is not. Thus, the rejection should be withdrawn.

17. Claim 1 has been rejected for reciting "in particular a removable plate of the microplate type." Office action, ¶ 17. The present version of the claims avoids this issue. Thus, the rejection should be withdrawn.

18. Claim 1 has been rejected for reciting "each cavity exhibiting a volume of the order of a few tens of nanoliters." Office action, ¶ 18. The rejection contains several questions, suggesting that the terms are confusing. But even if, without admission, the terms were confusing, that finding would be insufficient to render the claim indefinite. A claim is sufficiently definite to satisfy the statutory requirement of section 112 paragraph 2 if one of ordinary skill in the art would understand the bounds of the claim when read in light of the specification. Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Most importantly here, a claim is definite if it is amenable to construction, however confusing that task may be. Exxon Research and Engineering Co. v. United States, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001). In other words, if the meaning of the claim is discernible, the claim avoids a rejection on indefiniteness grounds. Id.



In this rejection, the quoted term is amenable to claim construction, since its words have meanings that are available, e.g., from dictionaries. Thus, the rejection should be withdrawn.

19. Claim 1 has been rejected for reciting "able to sample a determined amount of constituent and to deliver drops of volume of the order of a nanoliter." Office action, ¶ 19. But even if, without admission, the term were "awkward," that finding would be insufficient to render the claim indefinite. Indeed, a claim is not indefinite merely because of the type of language used to define the subjected matter. MPEP § 2173.01. Although the Examiner's suggestions for amendment are appreciated, and in part were adopted (--- on --- for "of") it is respectfully submitted that the rejection should be withdrawn.

20. Claim 1 has been rejected because it recites allegedly "confusing" terms, namely, both "means for displacing the piezoelectric micropipette" and "means of relative displacement of the piezoelectric micropipette and of the sample plate." Office action, ¶ 20. Confusion, as already noted, is not a basis for an indefiniteness rejection. Thus, this rejection should be withdrawn.

21-25. Claim 1 has been rejected for various reasons. Office action, ¶¶ 21-25. The present version of the claim avoids these issues, and thus the rejections should be withdrawn.

26-30. Claims 2 and 3 have been rejected for various reasons Office action, ¶¶ 26-30. Claims 2 and 3 are cancelled, and therefore the rejections are moot.

31. Claims 1-4 have been rejected for not defining "the first supply plate, second supply plate, and removable plate for samples over each other." Office Action, ¶ 31. The present version of the claims avoids this issue. Thus, the rejection should be withdrawn.

32. Claim 2 has been rejected. Office action, ¶ 32. As claim 2 is cancelled, the rejection is moot.

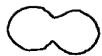
33. Claims 1-4 have been rejected for "failing to conform to current U.S. practice." The present version of claims avoids this issue, and thus the rejection should be withdrawn.

Rejections- 35 U.S.C. § 102(b)

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/44134 to Gamble *et al.* Office action, ¶ 35. These claims have been cancelled, and the rejection should be withdrawn. Additionally, the present version of the claims avoids this issue.

A reference anticipates a claim only if that reference describes each and every element of the claim. MPEP § 2131. If even just one element is absent from the reference's particular disclosure, that disclosure neither describes nor anticipates the claim. *Id.* Such is the case in this rejection.

Specifically, according to the PTO, "[t]he micropipette (312) can transfer samples of a predetermined amount from each of the filled receptacles of the first and second supply plates along at least two perpendicular axes Y and Z" Office action, pp. 10-11. Applicants respectfully submit that the cited passages of Gamble *et al.* neither disclose nor describe a piezoelectric micropipette "wherein said micropipette is able to sample a predetermined amount of said first and/or second constituents and to deliver constituent of a volume on the order of a nanoliter." As clearly shown in Figure 10 of Gamble *et al.*, micropipette 310 samples liquids from plate 306 and delivers it to jets 312, but not to another plate. Gamble *et al.*, p. 15, ll. 2-5. Moreover, Applicants respectfully submit that the jets 312 of Gamble *et al.*



cannot sample any liquid from a plate. Gamble *et al.*, p. 15, ll. 2-22. Applicants respectfully submit that Gamble *et al.* requires both pipette 310 and jets 312 to sample a liquid from one plate and deliver to a second plate.

Furthermore, the PTO even admitted that Gamble *et al.* is deficient for anticipation, as "Gamble et al. do not explicitly disclose withdrawing fluids from the receptacles of each of the first and second supply plates and dispensing the fluids into a removable plate for samples." Office action, p. 15. Therefore, Applicants respectfully submit that the cited passages of Gamble *et al.* neither disclose nor describe the present invention, and the rejection should be withdrawn.

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/44134 to Gamble *et al.* Office action, ¶ 36. These claims have been cancelled, and the present version of the claims avoids this issue.

Specifically, according to the PTO, "[t]he micropipette (108) can transfer samples of a predetermined amount from each of the filled receptacles of the first and second supply plates along at least two perpendicular axes Y and Z" Office action, p. 12. Yet Applicants respectfully submit that the jetting device 108 of Gamble *et al.* cannot sample liquids from plate. Gamble *et al.*, p. 12, l. 7-p. 13, l. 8; Fig. 6. As shown in Figure 2 of Gamble *et al.*, the jetting device 108 is linked to a reagent tank, and a unique pipette is needed for each reagent. *See also*, Gamble *et al.*, p. 12, ll. 27-31. Furthermore, as noted above, the PTO even admitted that Gamble *et al.* is deficient for anticipation. Therefore, Applicants respectfully submit that the cited passages of Gamble *et al.* neither disclose nor describe the present invention, and the rejection should be withdrawn.

Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by WO 97/44134 to Gamble *et al.* Office action, ¶ 37. These claims have been cancelled. Also, the present version of the claims avoids this issue.

Specifically, according to the PTO, "[t]he micropipette (164) can transfer samples of a predetermined amount from each of the filled receptacles of the first and second supply plates along at least two perpendicular axes Y and Z" Office action, p. 13. Yet Applicants respectfully submit that the jetting device 164 of Gamble *et al.* cannot sample liquids from plate. Gamble *et al.*, p. 13, l. 9-p. 14, l. 2; Fig. 7. Furthermore, as noted above, the PTO even admitted that Gamble *et al.* is deficient for anticipation. Therefore, Applicants respectfully submit that the cited passages of Gamble *et al.* neither disclose nor describe the present invention, and the rejection should be withdrawn.

Rejections- 35 U.S.C. § 103

Claims 1-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 97/44134 to Gamble *et al.* in view of U.S. Patent No. 6,083,763 to Balch. Office action, ¶ 41. These claims have been cancelled. Also, the present version of the claims avoids this issue.

To establish a prima facie case of obviousness, the PTO must identify a desirable reason for doing what the inventor has done, i.e., a desirable reason to reach the claimed invention. MPEP § 2142. Yet a desirable reason is absent from the present rejection, which is improper and should be withdrawn.

According to the PTO, the teachings of Gamble *et al.* are deficient, as "Gamble *et al.* do not explicitly disclose withdrawing fluids from the receptacles of each of the first and second supply plates and dispensing the fluids into a removable plate for samples." Office



action, p. 15. To remedy this deficiency, the PTO combines the teachings of Gamble *et al.* with those of Balch, which the PTO urges "shows the capillary tubes in fluid communication with the storage vessels" Office action, p. 15.

And what desirable reason to combine these teachings has the PTO identified? None. Indeed, the PTO even admitted that no desirable reason exists, because, according to the PTO, "Blach does not explain the significance of the configuration and the method." Office action, p. 15. The PTO, nevertheless, concluded that "the absence of the explanation proves the non-criticality of the configuration" Office action, p. 16. But this conclusion is logically invalid, as it is a conclusion based on all negative premises. (The PTO's position might be fairly rephrased as follows: Balch does not explain X's significance; Gamble does not explain X's significance; therefore, X is noncritical.). Indeed, one cannot draw any conclusion from all negative premises.

Admitting the absence of a reason for combining/modifying these teachings, the PTO merely combined/modified these teachings for no identified reason. But even if references can be combined or modified, that itself cannot render the resultant combination obvious unless the prior art also suggests the combination's desirability. MPEP § 2143.01. And, here, the desirability is absent from the evidence and explanation of record. Thus, the rejection is improper and should be withdrawn.

CONCLUSION

As the above-presented amendments and remarks address and overcome all of the rejections presented by the Examiner, withdrawal of the rejections and allowance of the claims are respectfully requested. No new matter has been added.


If there are any questions concerning this application, the Examiner is courteously invited to contact the undersigned counsel.

Respectfully submitted,

Date

5/6/13

By

 (45,945)
SEAN A. PASSINO FOR

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5569
Facsimile: (202) 672-5399

Stephen B. Maebius
Attorney for Applicant
Registration No. 35, 264

Attachment: Abstract of the Disclosure

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.